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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,703	10/24/2003	Joseph M. Koenig JR.	TRI4546P0161US	9791
32116 7590 06/30/2008 WOOD, PHILLIPS, KATZ, CLARK & MORTIMER 500 W. MADISON STREET SUITE 3800 CHICAGO, IL 60661				
EXAMINER RACHUBA, MAURINA T				
ART UNIT		PAPER NUMBER		
3723				
MAIL DATE		DELIVERY MODE		
06/30/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/692,703

**Applicant(s)**

KOENIG, JOSEPH M.

**Examiner**

Maurina Rachuba

**Art Unit**

3723

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 5 and 9 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Kingman, 2,386,900 in view of Meyer, 5,429,545. '900 discloses the claimed invention except for the pad core being made from a flexible, compressible, polymeric foam. '545, in a similar hand held abrasive tool, teaches making the tool core from a flexible, compressible polyurethane (polymer) foam. Because both '900 and '545 teach providing a core, and bonding abrasive grit to the core to form the tool, it would have been obvious to one skilled in the art to substitute one material for the other to achieve the predictable result of a hand held tool that conforms to the shape of the workpiece. Further, '900 does not explicitly disclose that the curved edge defines a radius not less than about 1/8 inch at any location on the curved edge. '900 does disclose that the edge is curved. It would have been an obvious matter of design choice to have made the curved edge of whatever size of curvature desired, since such a modification would have involved a mere change in the size of a component. A change

in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Here, '900 teaches, column 4, lines 9-18, that the curved portions of the tool may be made to fit the curved portions of the work piece. It would have been obvious to one of ordinary skill to have provided '900 with the claimed radius of curvature, dependent on the shape of the work piece being sanded. Note that '900 discloses that all sides of the block may be abrasive, figures 3 and 4, which meets the limitations of claim 9.

4. Claims 3, 4, 6- 8 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kingman '900 in view of Meyer, 5,429,545 as applied to claim 1 above, and further in view of Hayes, 2,553,254. '900 as modified by '545 does not disclose the sharp edge defined by an acute angle in the range from about 55 to 70 degrees. '254, in a similar abrasive tool, teaches providing a sanding block conforming, when viewed macroscopically before the sanding block becomes worn, substantially to a block having two expansive sides, top and bottom 3, and two adjacent sides, left and right, 2, wherein a given one of the expansive sides is abrasive, wherein the given one of the expansive sides has two opposite edges, at each of which one of the adjacent sides adjoins the given one of the expansive sides. "254 does not explicitly disclose that the edges are sharp or curved, but does clearly show in the drawings that the angle between one of the expansive and adjacent surfaces is between from about 55 to 70 degrees. MPEP 2125 states: Drawings and pictures can anticipate claims if they clearly show the structure which is claimed. *In re Mraz*, 455 F.2d 1069, 173 USPQ 25 (CCPA 1972). Here, '254 clearly discloses that the acute angle (measured from a vertical line

extending from the edge) formed by the expansive and adjacent sides is between about 55 to 70 degrees. If applicant argues that '254 does not disclose the claimed range, it is the examiner's position that '254 does at the least, teach that the angle between the expansive and adjacent sides be less than 90 degrees, and that the size of the angle, as long as it is less than 90 degrees, is not critical to applicant's invention, as the size of the angle would depend on the shape of the work piece being sanded. '900 discloses that the adjacent sides adjoining the expansive sides are also abrasive, see figures 3 and 4.

#### ***Response to Arguments***

5. Applicant's arguments filed 10 January 2008 have been fully considered but they are not persuasive. Applicant has stated that the examiner has not addressed the argument that one of ordinary skill would not replace the a substantially rigid body or core with a flexible compressible material, because Kingman clearly teaches that the rigid body or core is required for his invention to function, and therefore Kingman teaches away from such a substitution. It is the examiner's position that this argument has been answered, in both the previous bodies of the rejection and responses to arguments, However, the examiner will again respond.

6. Kingman discloses that the core of the tool is substantially rigid, and that the outer abrasive periphery of the tool is made of a conformable, deformable, resilient material, which allows the tool to be used to conform to corners etc. See Kingman, page 2, lines 11-60. It is the examiner's position that Kingman therefore teaches the desirability of providing at least part of the tool with a material that is flexible and

compressible. There is no teaching in Kingman against providing at least part of the tool of a flexible and compressible material. Meyer, for example column 1, lines 23-column 2, lines 46, teaches making an abrasive tool of a flexible and compressible polymer material, allowing the entire tool to flex and conform to a desired shape. It would have been obvious to have provided Kingman, who teaches providing at least some part of the tool with a flexible and compressible material, with the entire tool made of such material, the material being a polymer, for the predictable result of allowing the entire tool to conform to a surface being abraded.

7. Applicant is apparently arguing that if a reference expressly teaches a structure, that there is never a reason to modify that structure. This is not correct. Please refer to MPEP 2141. The substitution of one known material for another known material would be obvious, for the predictable result of providing that material's known properties.

8. Applicant further argues that Kingman already benefits from at least part of the tool having a flexible, compressible material and therefore one of ordinary skill would not consider it obvious to provide Kingman with the material of Meyer. Again, the examiner disagrees. Kingman benefits from the outer layer's ability to conform to angled surfaces, as disclosed in the example of a pie pan, while Meyer clearly teaches that by providing the material as claimed, the tool will conform to larger curved surfaces, as shown in the figures, without damage to those surfaces.

9. The previous action clearly set forth the motivation for combining the teachings of Kingman and Meyer. Kingman teaches a tool having the claimed shape, and at least part of the tool being flexible and compressible, while Meyer clearly teaches making a

tool with the entire tool being of a material that is flexible and compressible, to allow the entire tool to conform to the surface being abraded.

10. Please note that as the claims were previously considered, as the rejections have remained the same as previously set forth, and as it is the examiner's position that all arguments were previously considered, this action is made final.

***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurina Rachuba whose telephone number is 571 272 4493. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571 272 4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Rachuba/  
Primary Examiner, Art Unit 3723